

In re Application of Radford et al.  
Application No. 10/790,566

### REMARKS

#### *The Pending Claims*

Claims 3-6 have been amended, and claims 1, 2, 9, and 10 have been canceled. Also, new claims 11-26, each of which depends from one of claims 3-6, have been added. Thus, claims 3-8 and 11-26 currently are pending in the application.

#### *Summary of the Office Action*

The Office Action sets forth a two-way restriction requirement requiring Applicants to elect the claims of group I (i.e., claims 1-8) or group II (claims 9 and 10) for further prosecution.

The Office Action rejects claims 1 and 2 under 35 U.S.C. § 112, first paragraph, as allegedly reciting non-enabled subject matter. However, the Office Action states that claims 1 and 2 would be allowable if amended to overcome the section 112, first paragraph, rejection.

The Office Action provisionally rejects claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting as allegedly reciting subject matter that is unpatentable over the claims of copending application No. 10/615,283.

The Office Action acknowledges that claims 3-8 recite subject matter that is patentable over the prior art, but objects to the claims insofar as they depend from one or more rejected base claims.

#### *Discussion of the Restriction Requirement*

In response to the restriction requirement set forth in the Office Action, Applicants elect, without traverse, the invention of group I (i.e., claims 1-8) for further prosecution. Accordingly, claims 9 and 10 have been canceled, without prejudice or disclaimer of the subject matter recited therein, as being directed to a non-elected invention.

#### *Discussion of the Claim Amendments*

Claims 3-6 have been amended to incorporate the elements of the claims from which they originally depended, including the elements of any intervening claims. Accordingly, claims 1 and 2 have been canceled. As noted above, claims 9 and 10 have also been canceled as being directed to a non-elected invention. The

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aforementioned amendments and cancellations have all been made without prejudice or disclaimer of the subject matter recited in the claims as filed, and Applicants expressly reserve the right to pursue such subject matter, or any portion thereof, in an appropriate continuing application.

*Discussion of the Specification Amendments*

The specification has been amended to correct minor errors in the structure of Formula (I) appearing on page 7 and the structure of Formula (II) appearing on page 8. In particular, the paragraphs have been amended to correct inadvertent errors in the placement of bonds within the structures. No new matter has been added by way of these amendments.

*Discussion of the Section 112, First Paragraph, Rejection*

As noted above, claims 1 and 2 have been canceled, without prejudice or disclaimer of the subject matter recited therein. Accordingly, Applicants respectfully submit that the section 112, first paragraph, rejection of claims 1 and 2 has been rendered moot and should be withdrawn.

Furthermore, Applicants note that the Office Action suggests that the structures appearing on pages 7 and 8 of the specification have been reversed. However, Applicants respectfully note that the structure appearing on page 7 of the specification depicts a benzotriazole derivative, in which a triazole ring is coupled to a benzene ring. Also, Applicants respectfully note that the structure appearing on page 8 of the specification depicts a lactone derivative, which contains a five-membered cyclic ester (i.e., a lactone). Thus, Applicants respectfully submit that the structures set forth in the specification faithfully depict the particular classes of compounds named therein.

*Discussion of the Non-Statutory Double Patenting Rejection*

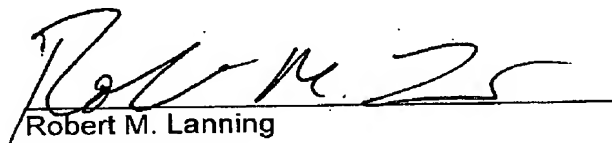
As note above, claims 1 and 2 have been canceled. Therefore, Applicants respectfully submit that the obviousness-type double patenting rejection has been rendered moot and should be withdrawn.

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*Conclusion*

In view of the foregoing, the application is considered in proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone interview would expedite prosecution of the instant application, the Examiner is invited to call the undersigned.

Respectfully submitted,



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